

REMARKS

Claims 1-13 and 18-40 are pending in the application. All claims stand rejected. Claims 1-13 and 18 stand rejected under 35 U.S.C. §112, second paragraph, for indefiniteness regarding the axial distance description set forth in claim 1. Claim 39 is also objected to as being inconsistent with claim 22 from which it depends. Claims 1-13, 18-20, 22-37 and 40 stand rejected under 35 U.S.C. §103 as being unpatentable over Yokoda, JP 2-221731 in view of Gallmeyer, U.S. Patent No. 5,660,256. Finally, claims 21 and 38 stand rejected under 35 U.S.C. §103 as being unpatentable over Yokoda in view of Gallmeyer and further in view of Kogyo, JP 08177976 A.

Applicant traverses each of the rejections set forth in the Office Action and submits that the case, as presently amended, is in a condition for allowance. By the foregoing amendments, Applicant has clarified independent claims 1 and 22, cancelled claims 39 and 40, and added new independent claim 41 and dependent claims 42-49. The new claims are directed toward the embodiment shown in Figure 6. The amendments to independent claims 1 and 22 should overcome the objections under 35 U.S.C. §112, second paragraph, set forth in the Office Action. Specifically, the amendments clarify the distance relationships between the supporting elements, mass member and fixing sleeve. Amended claim 22 eliminates any potentially conflicting language with claim 39. For these reasons, the rejections under 35 U.S.C. §112 should be withdrawn.

Claim Rejections Under 35 U.S.C. §103

Applicant maintains that a *prima facie* case of obviousness has not been established in the Office Action dated November 10, 2005. In particular, Applicant requests reconsideration of the response to Applicant's previous arguments as set forth in paragraph 9 of the Office Action. Regarding the motivation to combine Yokoda and Gallmeyer, the Office Action is non-responsive to Applicant's arguments as to why Yokoda and Gallmeyer would not be combined to arrive at the presently claimed

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invention. Specifically, the Office Action cites column 2, lines 33-41 of Gallmeyer as suggesting the combination of Gallmeyer with the damper of Yokoda. The citation, however, only refers to the ability of the Gallmeyer damper to allow for changes in the harmonic frequency range by adding, deleting or modifying the connecting member. Similarly, the entirety of the Yokoda reference is directed to improving the performance of the damper by supporting a mass member by two elastic legs wherein the ratio of the spring constant of the elastic leg parts supporting the mass member are different. Importantly, neither reference identifies or addresses the advantages provided by the claimed invention. In particular, because the supporting elements of the claimed invention are arranged at the mass member around the circumference and spaced at a distance from one another, the claimed device allows the annular chamber around the driveshaft under the mass member to be well ventilated. Thus, humidity which may be present in the annular chamber and which can lead to corrosion can escape or evaporate, thus reducing the risk of corrosion at the driveshaft. (See paragraph [0010]). The entirety of the background of the present application also describes the disadvantages of prior art vibration damping devices like Yokoda which are not ventilated and can lead to corrosive problems at the driveshaft location wherein the damper is used. The problems solved by the present invention are not addressed in Yokoda or Gallmeyer.

Accordingly, the obviousness rejections which all rely upon Yokoda and Gallmeyer should be withdrawn because the assertion that one of skill in the art would have been motivated to combine Gallmeyer and Yokoda cannot be supported. The fact that one of skill in the art may have the capabilities to arrive at the invention is not the test for whether one of skill in the art would have arrived at the invention based on the teachings of the prior art. *Ex Parte Levengood*, 28 USPQ2d 1300-1301, 1302 (BPAI 1993) ("That which is within the capabilities of one skilled in the art is not synonymous with obviousness.") The focus must remain on what the prior art suggested to one of skill in the art at the time the invention was made.

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In this case, the motivation to combine Gallmeyer and Yokoda is speculative, or improperly relies upon hindsight in view of the Applicant's claimed invention, because neither reference identifies or is directed toward solving the problems addressed by the present invention. In other words, the Office Action errs in defining the invention in terms of its solution in the selection of the prior art references. The Office Action's conclusion that the missing features of Yokoda would be suggested by the nature of the problem to be solved is legally erroneous because the problem solved by the claimed invention is not identified in any of the prior art references. *Van Veen vs. US*, 156 USPQ 403, 405 (Ct. Cl. 1967). Accordingly, Applicant submits that none of the obviousness rejections which rely upon Gallmeyer and Yokoda are legally supportable and therefore should be withdrawn. A person of skill in the art with knowledge of Yokoda, would not look to Gallmeyer to provide the claimed invention because neither Gallmeyer nor Yokoda are related to the problems addressed by the present disclosure. Without using the present claims as a template for modifying the prior art, the references relied upon cannot be validly combined to support the obviousness rejections. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577 (Fed. Cir. 1984) ("It is impermissible to use the patent itself as the source of suggestion.")

Applicant further traverses the suggestion in the Office Action at paragraph 9 that Figure 6 of Yokoda supports the obviousness rejection of claim 22, rather than Figure 4. Figure 6, like Figure 4, clearly includes two fixing sleeves. All of the claims require that the device include only a single fixing sleeve. Page 15 of the Yokoda translation describing Figure 6 states that "the fixed part 22b of one elastic leg part 22 and the fixed part 23b of the other elastic leg part 23 are fixed by fastening with the band 7." In this example, too, the spring constant associated with fixing element 22 differs from the spring constant associated with fixing element 23. Nevertheless, two fixing elements are disclosed and required by Yokoda. Clearly, the combination of Yokoda and Gallmeyer fails to disclose or suggest Applicant's claimed feature of a single elastic fixing sleeve. For this reason, all of the obviousness rejections set forth in the Office Action with regard to claims 22-37 should be withdrawn. Furthermore, for at least the same reasons, new claims 41-49 are also allowable.

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In sum, no valid reason has been shown as to why one of skill in the art would modify the Yokoda reference to arrive at the claimed invention particularly because the Yokoda and Gallmeyer references do not address the corrosion problem addressed by the present invention. Further, because the supporting elements of the claimed devices are arranged nearer to the open end of the mass member than to the fixing sleeve, it is possible to adapt the vibration damper of the present invention to lower frequency resonances of the shaft which was not possible with prior art vibration dampers such as disclosed in Yokoda or Gallmeyer.

Furthermore, the obviousness rejection should be withdrawn because the lack of teaching or suggestion of Applicant's plurality of circumferential spaced elastic supporting elements extending along only a portion of the length of the mass member and arranged at a first distance from an end of the mass member opposite the fixing sleeve and at a second distance greater than the first from an end of the mass member next to the fixing sleeve (claim 1). Nor does the combination of references disclose or suggest that the supporting elements are connected to the mass member so as to be arranged completely axially outside the length of the mass member (claim 22), or partially axially outside and partially axially inside the length of the mass member (claim 41).

Finally, Applicant notes that the Gallmeyer reference does not disclose any fixing sleeve whatsoever. Thus, Gallmeyer cannot support the modification of Yokoda to have supporting elements arranged in an axial distance from an end of the mass member opposite the fixing sleeve (claim 1), or that the supporting elements be axially outside the mass member opposite a fixing sleeve (claim 22), or partially outside the mass member opposite a fixing sleeve (claim 41). For all of these reasons, Applicant submits that the obviousness rejections which rely on the combination of Yokoda and Gallmeyer should be withdrawn because, either alone or in combination, these references fail to disclose or suggest each and every feature of Applicant's claimed invention.

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Having overcome all of the objections and rejections set forth in the Office Action, the Applicant submits that the case is in a condition for allowance, and a Notice of Allowability is therefore earnestly solicited. The Examiner is invited to telephone the Applicant's undersigned attorney at (248) 223-9500 if any unresolved matters remain. The Examiner is further authorized to charge any fees or credit any overpayments to Deposit Account No. 50-0476 in the name of John A. Artz, P.C. should any fee adjustments be necessary in view of the newly presented claims.

Respectfully Submitted,

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